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Paper No. 30

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COPY MAILED

OCT 29 2003

OFFICE OF PETITIONS

DECISION DISMISSING PETITION

In re Patent No: 6,431,874 B1
Issue Date: August 13, 2002
Application No. 09/427,447
Filed: October 27, 1999
Patentee: Syznalski

This is a decision on the communication filed by facsimile transmission on June 5, 2003, styled as a response under 37 CFR 1.322(a)(4) and a petition under 37 CFR 1.181, seeking the USPTO stay its proposed issuance of a Certificate of Correction for the above-identified patent, which is being treated as a petition under 37 CFR 1.181 seeking reconsideration of the Office communication of May 6, 2003, which indicated that a Certificate of Correction under 35 U.S.C. § 254 and 37 CFR 1.322 was forthcoming.

The petition is **dismissed**.

BACKGROUND

The above-identified application was filed on October 27, 1999. The originally presented claims were drawn to a method (claims 1 through 10) of, and composition of matter (claims 11 through 20) for, helping a tobacco smoker stop smoking, which in element (C) that was common to all 20 claims, employed lobelia in an amount effective to reduce the smoker's craving for nicotine.

In reply to the final Office action of June 26, 2001, which treated claims 1 through 20, applicant filed an amendment on August 3, 2001, under 37 CFR 1.116 which canceled claims 2 through 5, 7 through 10, 12 through 15, and 17 through 20, leaving claims 1, 6 (dependent on claim 1), 11, and 16 (dependent on claim 11) remaining. This being the first amendment, it was lettered as amendment "A" in red ink on the correspondence itself and also on the contents section of the file on the line accorded to its paper number.

The Office action of August 24, 2001, reopened prosecution. The action indicated that the amendment of August 3, 2001, had been entered, and that a new ground of rejection was being applied. The action inadvertently mentioned only the independent claims 1 and 11, and rejected these claims on the ground of anticipation over the Cooper reference, but was silent as to the disposition of dependent claims 6 and 16.

A reply to the Office action of August 24, 2001, was filed on September 25, 2001. The accompanying amendment to independent claims 1 and 11 broadened element (C) to now recite --an anti-smoking drug-- in place of the formerly more limited "lobelia." Pursuant to 37 CFR 1.121(c)(3), the amendment presented two concurrent versions of claims 1 and 11: a "clean" version, and the "marked-up" version required by 37 CFR 1.121(c)(1)(ii) showing (by bracketing and underlining) how these claims were being changed by the current amendment. The remarks in the amendment also requested

withdrawal of the previous cancellation of claims 7, 8, 17, and 18, but applicant did not reinstate these claims in the manner required by 37 CFR 1.121(c)(2), i.e., by presentation as new claims with new claim numbers. Additionally, the amendment presented new claims 21 through 24, which did not correspond to previously canceled claims 7, 8, 17, and 18, and instead further limited -- an anti-smoking drug-- of element (C) of the two independent claims to --an antidepressant-- in claims 21 and 23, and -- an antidepressant-- in turn was further limited to --lobelia-- in claims 22 and 24. This being the second amendment, it was serially lettered as amendment "B" in red ink on the correspondence itself as well as on the contents section of the file wrapper corresponding to its paper number.¹

The final Office action of December 4, 2001, rejected claims 1, 11, and 21 through 24 under 35 U.S.C. 112 first paragraph, due to the broadening of the claims to now cover an "anti-smoking drug" instead of the originally recited "lobelia". The action noted (at 2) that the rejection would be overcome and the claims would be allowable if the claims were again limited to --lobelia-- The examiner further volunteered that "[t]his may be accomplished by Examiner's Amendment, with applicant's authorization." The final Office action again inadvertently did not specifically mention the disposition of pending dependent claims 6 and 16, notwithstanding their continued presence in application as shown by the Index of Claims and the contents of the file.

A telephonic interview between the examiner and counsel was conducted on December 14, 2001, as memorialized in the Interview Summary form attached to the Notice of Allowability of January 15, 2002 (attachment 4). The Notice of Allowability also included an attached Examiner's Amendment (attachment 6) indicating counsel's authorization given during the aforementioned interview to change, in element (C) of independent claims 1 and 11, "an anti-smoking drug" to --lobelia--, and cancel claims 21 through 24. The Notice of Allowability also included a Notice of References Cited (attachment 1), and an Examiner's Statement of Reasons for Allowance (attachment 8). The examiner's amendment to claims 1 and 11 was entered by hand in red ink, per MPEP 1302.04², albeit on the "marked-up" version of these claims. This being the third amendment, it was serially lettered as amendment "C" in red ink on the correspondence itself as well as adjacent to the changes made in the "marked-up" version of claims 1, 11; on the Index of Claims section of the file wrapper; and also on the contents section of the file on the line accorded to its paper number. The Notice of Allowability again inadvertently specifically mentioned only independent claims 1 and 11 (as being allowed) and did not indicate the disposition of pending dependent claims 6 and 16. The Notice of Allowance mailed the same date also indicated that the total number of claims being allowed was 2 (sic, 4).

¹ Since the Commissioner's Order No. 1733 of July 19, 1907, amendments are also lettered serially in the file. See Wolcott, Manual of Patent Office Procedure, 9th Ed., Patent Office Society, (1946) at 73-74.

² *Manual of Patent Examining Procedure* (MPEP), 8th Ed., (Aug. 2001). The MPEP has no binding force on the courts, but it commands notice as an official interpretation of statutes and regulations with which it does not conflict. Patent attorneys, examiners, and the public commonly rely on the MPEP as a guide in procedural matters. *In re Kagan*, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967); *Syntex v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 1571 n.3, 11 USPQ2d 1866, 1867 n.3 (Fed. Cir. 1989); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984).

On February 4, 2002, the examiner mailed a corrected Notice of Allowability that correctly indicated that the allowed claim numbers were in fact 1, 6, 11, 16; *i.e.*, that 4 claims were being allowed.

On March 5, 2002, applicant filed an amendment under the provisions of 37 CFR 1.312 that reinstated the subject material of previously canceled claims 7, 8, 17, and 18, (inadvertently retaining the same claim numbers notwithstanding 37 CFR 1.121(c)(2), but entered in the "Index of Claims" section of the file wrapper as claim numbers 25 through 28.) The accompanying remarks confirmed that the allowed claims were 1, 6, 11, and 16, and that the reinstated claims were needed to overcome "an apparent misunderstanding" regarding the status of claims 7, 8, 17, and 18.

On May 7, 2002, a "Response to 312 Communication" was mailed, indicating that the amendment filed under 37 CFR 1.312 on March 5, 2002, had been entered.

The patent issued August 13, 2002, with claims 1, 6, 11, 16, and 25 through 28 numbered as 1 through 8, respectively. However, the agreed-to changes to limit the claims in part (C) to "lobelia" set forth in the examiner's amendment of January 15, 2002, were not reflected in the printed patent. The patent as printed correctly did not include canceled claims 21 through 24.

On May 6, 2003, a letter regarding a proposed Certificate of Correction under 35 U.S.C. § 254 to correct the obvious USPTO printing mistake was mailed to patentee under the provisions of 37 CFR 1.322(a)(4).

The instant petition was filed June 4, 2003.

STATUTE AND REGULATION

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

The Office...may establish regulations, not inconsistent with law, which...
(A) shall govern the conduct of proceedings in the Office.

35 U.S.C. § 10 states in pertinent part:

(1) The Director may publish in printed, typewritten, or electronic form, the following:
(A) Patents and published applications for patents, including specifications and drawings, together with copies of the same...

35 U.S.C. § 131 states:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. § 254 provides that:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be

attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

37 CFR 1.2 states in pertinent part:

All business with the Patent and Trademark office should be transacted in writing... The action of the Patent and Trademark Office will be based exclusively on the written record in the office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Effective March 1, 2001, 37 CFR 1.121 stated in pertinent part:

(C) Claims. -

- (1) Amendment by rewriting, directions to cancel or add. Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

- (2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.
- (3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up

version will constitute an assertion that it has not been changed relative to the immediate prior version....

- (g) Exception for examiner's amendments: Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2) or (c)(1) of this section is not required.

37 CFR 1.133(b) states:

In every instance where reconsideration is requested in view of an interview with the examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111 and 1.135.

37 CFR 1.312 states:

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the application from issue.

37 CFR 1.322 states:

(a)(1) The Director may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

- (i) At the request of the patentee or the patentee's assignee;
 - (ii) Acting *sua sponte* for mistakes that the Office discovers; or
 - (iii) Acting on information about a mistake supplied by a third party.
- (2) (i) There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section.
- (ii) Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.
- (3) If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.
- (4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

OPINION

Petitioner asserts that the patent was properly printed. Specifically, petitioner contends, (1) the records of the USPTO do not clearly and unambiguously show the claims were printed in error, (2) the alleged error is not correctable under 35 U.S.C. § 254, and (3) the error alleged is not "of consequence" as allegedly required by § 254.

As to the first issue, the decision of the USPTO must necessarily be based on the written record in the USPTO. 37 CFR 1.2. Inspection of the written record of this file reveals that the examiner entered a rejection of claims 1 and 11 (under 35 U.S.C. § 112, first paragraph) upon their broadening by applicant to recite in element (C) "an anti-smoking drug", but advised applicant that if claims 1, 11 were corrected by being limited to --lobelia--, they would be allowable. Indeed, the examiner went so far as to invite an Examiner's Amendment to this effect, with, of course, applicants authorization.³ See Office action of December 4, 2001, (at 2). The formal Examiner's Amendment, an attachment to the Notice of Allowability of January 15, 2002, indicates that applicant's counsel agreed to the amendment proposed by the examiner, and the file shows that a copy of the amendment was mailed to applicant. The summary of the telephonic interview conducted on December 14, 2001, was memorialized by the Interview Summary that was also an attachment to the Notice of Allowability of January 15, 2002. The Examiner's Amendment also contained the caveat that "[s]hould the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312." While an amendment under 37 CFR 1.312 was filed on March 5, 2002, that amendment did not address any of the changes made by the aforementioned Examiner's Amendment, but instead reinstated the subject matter of previously canceled claims 7, 8, 17, and 18.

While petitioner contends that the "proposed examiner's amendment would have violated both law and internal Office procedure," there is simply no "proposed examiner's amendment" of record in this file.⁴ Rather, according to the contents of this file, the formal Examiner's Amendment of January 15, 2002, was agreed to by applicant's representative on December 14, 2001, created, a copy mailed to applicant, and is an entered paper in the prosecution history of this patented file. Contrary to petitioner's further contentions, the prosecution history of this file does not indicate that the outstanding Examiner's Amendment of January 15, 2002, was ever modified or withdrawn in whole or in part by the examiner, or by the applicant. The "Corrected Notice of Allowability" mailed on February 4, 2002, simply corrected an outstanding typographical error in the previous Notice of Allowability: the omitted disposition of dependent claims 6 and 16 was now clarified as also being allowed. See "Corrected Notice of Allowability," item 2.

³ As noted in MPEP 1302.04, a substantive amendment to the claims by the examiner is called a "formal examiner's amendment", and requires, *inter alia*, the applicant's approval, and that a copy be sent to the applicant. The Examiner's amendment of January 15, 2002, was such a formal examiner's amendment.

⁴ As to any alleged violation of law, as prosecution of the above-identified application was closed with the mailing of the Notice of Allowability, and further as the patent has issued, any issues regarding the correctness *vel non* of the prosecution on the merits will not be revisited. See MPEP 1701.

Petitioner's contention that the lack of any further mention in the corrected Notice of Allowability of February 4, 2002, of the other attachments to the Notice of Allowability of January 15, 2002, means the "erroneous Examiner's Amendment [was] withdrawn," simply lacks any basis in the record. Any further amendments to claims 1, 11, such as deleting "lobelia" in element (C) and substituting --an anti-smoking drug-- would have required another formal Examiner's Amendment under 37 CFR 1.121(g) that would, in turn, have required an Interview Summary, and a copy of this Examiner's Amendment would have been mailed to applicant and placed in the file. See MPEP 1309. Alternately, any further amendment to claims 1, 11 deleting "lobelia" and inserting --an anti-smoking drug-- initiated by applicant would have required the filing of another amendment under 37 CFR 1.312, and further, the examiner's formal approval of entry of the amendment. See MPEP 714.16. The only amendment in the written record that was filed under 37 CFR 1.312 did not amend claims 1, 11.

The written record of this file is conspicuously and unambiguously devoid of any further amendment to claims 1, 11 subsequent to the Examiner's Amendment of January 15, 2002. The claims that were passed to issue by the examiner remained limited to --lobelia--, and the patent as printed should have reflected this limitation.

Petitioner's attention is further drawn to the fact that if the lack of the checked boxes in items 1, 4, 6, and 8 of the Corrected Notice of Allowability meant these items had been "withdrawn" by the examiner, then the examiner's consideration of the Cooper reference (U.S. 5,055,478) listed on the PTO-892 Notice of References Cited attached to the Notice of Allowability of January 15, 2002, would also have been withdrawn and the as-printed patent would not reflect the Cooper reference. As the Cooper reference was listed among those cited on the patent as issued, it is clear that no "withdrawal" of any type occurred. Likewise, if the Corrected Notice of Allowability was somehow construed to mean the Examiner's Amendment of January 15, 2002, had been withdrawn, then the cancellation of claims 21 through 24 would likewise would have been rescinded, such that the corrected Notice of Allowability of February 4, 2002, would have indicated the allowed claims were now 1, 6, 11, 16, and 21 through 24, a circumstance that manifestly did not occur. Indeed, petitioner confirmed in his amendment filed under 37 CFR 1.312 on March 5, 2002, that the allowed claims were in fact 1, 6, 11, 16.

Rather, the written record of this file clearly shows an error in the claims of the patent as printed, and that such error arose from the USPTO. Simply put, the Examiner's Amendment "C" that replaced "an anti-smoking drug" in element (C) of claims 1, 11 as drafted in applicant's amendment "B" was entered on the "marked-up" versions of these claims, while the printer captured the "clean" version of these claims that had not physically been amended, for printing.⁵ However, it is axiomatic that any rewriting of a claim with the same claim number will be construed as a direction to cancel a previous version--or versions-- of the claim. See 37 CFR 1.121(c)(1)([t]he rewriting of a claim

⁵ Prior to March 1, 2001, an applicant's amendment to the claims was made by bracketing and underlining to show deletions and additions to the claims, respectively. Effective March 1, 2001, 37 CFR 1.121 was amended, see 65 F.R. 54604 (Sep. 8, 2000), to require applicants to submit, in addition to the classic "marked-up" version of the claim(s) as amended for the examiner's convenience, a "clean" [no bracketing or underlining] version of the same claim(s) as amended for the printer to capture by OCR scanning, to facilitate the patent publishing process. See 65 F.R. 54604 at 54639, response to comment 60.

(with the same number) will be construed as directing the cancellation of the previous version of the claim"); In re Beyers, 230 F.2d, 451, 455, 109 USPQ 53, 55 (CCPA 1956)(amendment of a claim by inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation). Here, the previous broad claims 1, 11 of applicant's amendment "B" filed September 25, 2001, were canceled and replaced by the later Examiner's Amendment "C" of January 15, 2002, which limited element (C) of all claims to --lobelia--. That is, both the "marked-up" and "clean" versions of claims 1, 11 as drafted by applicant in amendment "B" were replaced by the narrowing Examiner's Amendment "C," that limited all claims to --lobelia-- as a condition of patentability.

Inspection of the written record of the file further reveals the printer treated the "clean" version of claims 1, 11 as controlling by way of handwritten brackets and numerical pagination, both appearing in blue ink, that excluded from printing the "marked-up" but further limited version, but included the "clean" version for printing. Nevertheless, the "clean" version of claims 1, 11 was and is still clearly marked as amendment "B" (in red ink) and appeared on pages 2-3 of the amendment of September 25, 2001, while the "marked-up" versions of these claims that contained the Examiner's Amendment were clearly marked (in red ink) as the later "C" version of the claims, and appeared on pages 1, 2 of the same amendment. Likewise, the red "C" also appears where claims 21 through 24 were canceled by a red ink strike through when the Examiner's Amendment of January 15, 2002, was entered, as well by the red ink strike in the Index of Claims, showing that these claims and their numbers had been canceled, pursuant to MPEP 719.04. That is, the printer captured the "clean" version of the broadened claims 1, 11 of amendment "B", notwithstanding that the written record clearly showed that both versions of these previous claims ("clean" and "marked-up") had been canceled and replaced by the by the succeeding Examiner's Amendment "C" which, of course, limited all claims to --lobelia--. See 37 CFR 1.121(c)(1); Beyers, *supra*.

It is noted that 37 CFR 1.121(g) permits the examiner, by way of an Examiner's Amendment, to amend claims without having to present both "clean" and "marked-up" versions of the claims required by of applicant. That is, as here, the examiner can make additions or deletions to the claim(s) of record simply by way of instructions to make the change(s) at a precise location(s) in the claim(s). The record is devoid of any instructions by the examiner subsequent to the Examiner's Amendment of January 15, 2002, to make, or approve, further additions or deletions to claims 1, 11. Indeed, the record is devoid of any further additions or deletions of any type to claims 1, 11 after they were allowed, as amended by the Examiner's Amendment "C" on January 15, 2002. There is clearly no basis in the written record of this file for the claims to have been printed where element (C) contained the phrase "an anti-smoking drug" instead of --lobelia--.

While petitioner now disputes (at n.1) that it was mutually agreed to limit the claims to --lobelia-- in the interview of December 14, 2001, notwithstanding the memorialization in the Examiner's Interview Summary, as well as in the Examiner's Amendment, both attached to the Notice of Allowability, the written record of the above-identified application clearly fails to support this contention. See 37 CFR 1.2. If the substance of the interview as recorded by the examiner warranted correction or supplementation, it was incumbent upon applicant during the pendency of the above-identified application to correct or supplement the record in writing, and request reconsideration. See 37 CFR 1.2; 1.133(b); MPEP 713.04; Interview Summary Sheet attached to Notice of Allowability of January 15, 2002. There is clearly no evidence in the written record that applicant ever corrected or supplemented the substance of the interview as recorded by the examiner. Likewise, if the changes or additions set forth in the Examiner's

Amendment of January 15, 2002, were unacceptable to applicant, applicant was invited to file an amendment under 37 CFR 1.312. Applicant's amendment filed under 37 CFR 1.312 on March 5, 2002, while it did reinstate four previously canceled claims did not also seek to reinsert the previously refused broadening limitation of "anti-smoking drug" to claims 1 and 11, and delete the narrowing --lobelia--. There is clearly no evidence in the written record that applicant filed an amendment under 37 CFR 1.312 to undo or modify the changes or additions made by the Examiner's Amendment of January 15, 2002, much less that such an amendment was approved by the examiner.

Furthermore, while applicant contends that the corrected Notice of Allowability of February 4, 2002, which indicated the allowed claims were 1, 6, 11 and 16, somehow "corrected and withdrew" the allegedly erroneous Examiner's Amendment, such that the claims were rebroadened to "an anti-smoking drug," it is brought to petitioner's attention that the Examiner's Amendment "C" of January 15, 2002, also canceled claims 21 through 24. Thus, if the corrected Notice of Allowability upon which petitioner relies also operated to rescind the Examiner's Amendment of January 15, 2002, then the corrected Notice of Allowability would have indicated that the allowed claims were in fact 1, 6, 11, 16, and 21 through 24. Likewise, the written record does not show that, upon receipt of the corrected Notice of Allowability, applicant then considered the Examiner's Amendment "C" to have been vacated, as applicant expressly confirmed on March 5, 2002, that only claims 1, 6, 11, and 16 stood allowed, and not that claims 1, 6, 11, 16, and 21 through 24 stood allowed. See amendment of March 5, 2002 (at 2):

Claims 1, 6, 11 and 16 stand allowed. This Amendment to claims 7-8 and 17-18 is submitted under Rule 312 and M.P.E.P. 714.16. Note that this Amendment *does not affect (e.g., withdraw, change)* allowed claims 1, 6, 11, and 16 (emphasis in original)."

The amendment under 37 CFR 1.312 then went on to reinstate previously canceled claims 7, 8, 17, and 18, and did not address previously canceled claims 21 through 24.

With respect to the second issue noted above, petitioner contends that the legislative history of § 254 explains that the purpose of that statute is to allow the correction of clerical or typographical errors, *i.e.*, those errors that are immediately apparent upon reading the claims. Petitioner asserts that since the as-printed claims are not meaningless when read literally, correction is not required.

Nevertheless, whatever the legislative intent may have been in 1924 when the almost identically worded predecessor to current § 254 was drafted, the statute as written does not limit the USPTO to the issuance of certificates that correct only clerical or typographical errors caused by the USPTO. Rather, language limiting Certificates of Correction to clerical or typographical errors appears in 35 U.S.C. § 255, which speaks to mistakes in a patent arising from applicant, but such is immaterial to the instant situation involving errors arising from the USPTO. As the Federal Circuit noted when construing § 254 in Southwest Software v. Harlequin, 226 F.3d 852, 56 USPQ2d 1161 (Fed. Cir. 2000):

We begin the process of statutory interpretation with the language of the statute. See Van Wersch v. Department of Health & Human Servs., 179 F.3d 1144, 1148 (Fed. Cir. 1999) (citing VE Holding Corp. v. Johnson Gas Appliance Co., 917 F.2d 1574, 1579, 16 USPQ2d 1614, 1618 (Fed. Cir. 1990)). If the language is clear, the plain meaning is conclusive. See *id.* at 1152 (holding that Congressional intent, as clearly expressed in legislative history, could not

"trump the irrefutably plain [statutory] language that emerged when Congress actually took pen to paper").

Thus, contrary to petitioner's urging, the clear language of § 254 is not properly limited by further imposing legislative intent on the plain meaning of the statute. Furthermore, while Congress enacted 35 U.S.C. § 255 in 1952 to provide Certificates of Correction for the correction of minor clerical or typographical errors in a patent made by the applicant, it did not concurrently amend § 254 to limit its scope to the correction of minor clerical or typographical errors made by the USPTO. As such, applicant's proposed imposition of additional constraints on § 254 is not persuasive. See St. Martin Evangelical Lutheran Church v. South Dakota, 451 U.S. 772, 786-88 (1981) (Congress in amending one section of a statute is not presumed to have intended an amendment to another section of the statute which had not been altered); Russell v. United States, 464 U.S. 16, 23 (1983) "[w]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion." As the plain language of § 254 does not further limit the "mistake" to clerical or typographical errors, correction of the USPTO printing mistake in question by way of a Certificate of Correction is clearly within the aegis of § 254.⁶

As to petitioner's contention that the claims as printed are not meaningless, and as such do not require correction, the question is, rather: whether the patent was printed in accordance with the record in the USPTO of the application as passed to issue by the examiner. Clearly, the claims were not so printed. Furthermore, as noted above, the mistake is immediately apparent when the content of the claims as printed are compared with the content of the written record in the USPTO of the application as passed to issue by the examiner.

Petitioner further contends that, pursuant to 35 U.S.C. § 282, the as-printed patent is presumed valid, and as such, this presumption of validity may only be rebutted by "clear and convincing" evidence. Since, petitioner maintains, the "proposed" Examiner's Amendment would have been incorrect as a matter of law and procedure, the USPTO allegedly rectified this error by printing the proper claims. As such, petitioner asserts the record fails to establish "clear and convincing" evidence of the alleged error.

Initially, as noted above, there is no "proposed" Examiner's Amendment in the record of this file. Inspection of the contents of this file reveals only the Examiner's Amendment of January 15, 2002, that is a permanent part of the record of this file. See MPEP 719.01. That same inspection fails to reveal any further modification, withdrawal, amendment or rescission, in whole or in part, of that Examiner's Amendment by either applicant or the examiner, that would support applicant's contention that the claims

⁶ The USPTO has a long history of issuing certificates of correction to correct errors in patents arising from its own internal processing, or its printing operation, that actually predates the liberal statutory authorization provided by § 254 and its 1924 predecessor statute. See McCrady, Patent Office Practice, 4th Ed. (1959) at 439. The USPTO originated mistakes in printed patents corrected by Certificates of Correction have run the gamut from the trivial, such as punctuation errors, to omitted drawings, and even to missing claims. Id. According to Workload Table 24 of the USPTO Annual Report for Fiscal Year 2000, the USPTO had averaged for a 5 year period a combined yearly total of about 16,000 Certificates of Correction under both § 254 and § 255. See <http://www.uspto.gov/web/offices/com/annual/2000>.

were correctly printed in the patent. Rather, inspection of the contents of this file clearly reveals that the scope of the patent claims as printed is incorrect. Furthermore, petitioner has not shown that the presumption of validity set forth in § 282 is applicable to the USPTO when it exercises its discretionary authority under § 254 and 37 CFR 1.322. As the court noted in Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, at 1534, 218 USPQ 871, at 875 (Fed. Cir. 1983):

The presumption, like all legal presumptions, is a procedural device, not substantive law. It does require the decision-maker to employ a decisional approach that starts with the acceptance of the patent claims as valid and that looks to the challenger for proof of the contrary. Thus the party asserting invalidity not only has the procedural burden of proceeding first and establishing a prima-facie case, but the burden of persuasion on the merits remains with that party until final decision... With all evidence in, the trial court must determine whether the party on which the statute imposes the burden of persuasion has carried that burden.

Petitioner has not shown, nor is it apparent, that the "clear and convincing" standard for proving invalidity applies to the USPTO when it exercises its discretionary authority under § 254. The standard set forth in § 254, which here controls, is "clearly disclosed," not "presumed valid." "Clearly disclosed" is not defined in the statute. However, "[a] fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning." Perrin v. United States, 444 U.S. 37, 42 (1979). "Clearly" is the adverbial form of "clear" which is defined as, *inter alia*, "easily visible," "free from obscurity or ambiguity: easily understood: unmistakable," and "free from doubt." Webster's Ninth New Collegiate Dictionary 247 (1985). "Disclosed" is the past tense of "disclose" which is defined as "to expose to view," "to make known or public". Id. at 360. Consequently, the ordinary, contemporary, and common meaning of clearly disclosed envisions anything that is easily understood, not obscure or ambiguous, and that is made known or exposed to view. It follows that the mistake in this patent is "clearly disclosed" within the (or any) meaning of § 254.

Since § 254 does not require the "clear and convincing" standard, petitioner has no reasonable basis to import this standard into § 254, and then impose this standard on the USPTO in this instance. See Southwest, supra. Rather, the "clear and convincing" standard applies to those infringement defendants who challenge the validity under § 281 of a patent or its claims either as issued, or as corrected by a Certificate of Correction. See Superior Fireplace Co. v. Majestic Products Co., 270 F3d. 1358, 60 USPQ2d 1668, 1674 (Fed. Cir 2001). Here, the USPTO is not a defendant in an infringement action who is asserting the invalidity of the patent or claims within the meaning of § 281. It follows that the USPTO does not here bear the "clear and convincing" standard of proof more correctly applicable to putative infringers under § 281. Rather, the USPTO is here asserting there is a mistake caused by the USPTO in this patent that is "clearly disclosed" by the records of the Office within the meaning of § 254. Compare In re Etter, 756 F2d. 852, 225 USPQ 1 (Fed. Cir 1985) where the court noted that the presumption of claim validity does not apply to USPTO in reissue applications under 35 U.S.C. 251 when ruling likewise for reexamination proceedings, and observed "the focus of both is on curing defects which occurred during a proceeding in the PTO, which was responsible for original issuance of the patent." § 254, like § 251, is found in Chapter 25, Title 35 United States Code entitled "Amendment and Correction of Patents." Like reissue and reexamination, the focus of § 254 is on curing defects which occurred during a proceeding in the USPTO which was responsible for the original issuance of the patent. Contrary to petitioner's assertion, it

does not automatically follow that the USPTO must meet the "clear and convincing" burden of proof of a mistake when it proposes to issue a Certificate of Correction under § 254 and 37 CFR 1.322.

Petitioner is reminded that the printing operation (under 35 U.S. C. § 10, see MPEP § 1309 *et seq.*), is distinct from the examining operation (under 35 U.S.C. § 131, see generally MPEP Chapter 700) within the USPTO, and that the determination of patentability *vel non* of the claims is performed in and by the examining, not the printing, operation. See 35 U.S.C. § 131 (" [t]he Director shall cause an examination to be made of the application and of the alleged new invention; and if it appears on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefore;" § 151 ("[i]f it appears that applicant is entitled to a patent under the law a written notice of allowance of the application shall be given or mailed to the applicant.") The examination, culminating in the determination of patentability indicated by the giving or mailing of the written notice of allowance is only performed in the examining operation, not the printing operation, of the USPTO. The subsequent patent printing operation, that "shall issue a patent therefore" is simply ministerial in nature and as such has no statutory, regulatory, or authority delegated from the Director, to modify, rescind, or abrogate the examining operation's prior determination of what constituted patentable subject matter. Indeed, 37 CFR 1.322(a)(1)(ii) permits any part of the USPTO to, *sua sponte*, initiate a Certificate of Correction to mitigate USPTO mistakes in a patent arising from e.g., the printing process. In any event, assuming *arguendo* the standard of proof of a mistake in a patent incurred by the USPTO is "clear and convincing" evidence, then the foregoing clearly demonstrates there is "clear and convincing" evidence in the written record that the narrowed claims limited to --lobelia-- that were passed to issue by the examiner were unfortunately not the broad claims that were printed. Compare the Office action of December 4, 2001, (at 2) with the Examiner's Amendment of January 15, 2002. Furthermore, there is no "clear and convincing" evidence of any further Examiner's Amendment within the meaning of 37 CFR 1.121(g) that specifically made changes and additions to element (C) of allowed claims 1 and 11, or of an amendment filed by applicant after allowance under 37 CFR 1.312, approved by the examiner, that canceled "lobelia" in element (C) and inserted --an anti-smoking drug.--

Petitioner further contends that the printing of these claims "by mistake" would have required the unlikely circumstance that the examiner, the Office of Publications, and the Office of Quality Review, each independently made an error. Assuming for the sake of argument that it was necessary for all three areas of the USPTO to have erred, § 254 only requires that the mistake in the above-identified patent be "clearly disclosed" and does not condition USPTO correction of the mistake on how it arose other than it be the fault of the USPTO. As noted above, the examiner (or the clerical staff) arguably erred⁷ in amending the "marked up" version of claims 1, 11 just as the printer arguably erred in capturing and printing the "clean [but now canceled] copy" of the prior, broadened claims. There is no written evidence in the record of this file that this application was reviewed, screened, or surveyed, by the Office of Quality Review. Even assuming such

⁷ While a careful reading of 37 CFR 1.121(g), the final rulemaking reported at 65 F.R. 54604, and MPEP 1302.04, fails to reveal that the examiner (or USPTO clerical staff) was expressly required to enter changes made by an Examiner's Amendment under 37 CFR 1.121(g) on the "clean" version of any amended claims, such was implied by the rule change adding the requirement for a "clean" version of the claims to facilitate their capture by OCR scanning during the printing process.

were the case, the Office of Quality Review reviews an allowed application to determine if any claims allowed by the examiner are in fact not patentable. See MPEP 1308.03. The Office of Quality Review does not proof read the efforts of the printing operation for errors in initial or final data capture. In any event, even assuming *arguendo*, that all three areas of the USPTO erred, that does not preclude correction of the mistake by way of § 254.

Petitioner further asserts that the alleged error is not subject to correction by a Certificate of Correction. Specifically, petitioner urges, and relies upon several reported decisions in support of his contention, that correction of the kind of error present herein, would entail changing the scope of an allowed claim, and that "cannot be corrected by a Certificate of Correction as a matter of law." Nevertheless, the decisional authorities (petition at 8-9) relied upon by petitioner simply do not address the instant situation, which is correction of a USPTO caused mistake under § 254 and its promulgating regulation 37 CFR 1.322. Rather, the decisional authorities relied upon by petitioner are all directed to Certificates of Correction seeking to correct a mistake caused by applicant under § 255 and its promulgating regulation 37 CFR 1.323. As noted above, and as detailed in the very authorities that petitioner relies on, Congress placed numerous limitations in § 255 that sharply limit attempts to correct mistakes arising from applicant in an issued patent by way of a Certificate of Correction.⁸ That Congress did not concurrently place the same limitations in § 254 in 1952 which deals with the USPTO correcting its own mistakes, clearly demonstrates that Congress intended that the USPTO have more freedom in correcting its own mistakes by way of a Certificate of Correction than a patentee would have in correcting his own mistakes by way of a Certificate of Correction. § 254 only sets forth "a mistake" which is manifestly not limited to typographical or clerical mistakes, and indeed "a" is not followed by any further restrictive modifier and, as such, "a mistake" is clearly inclusive of any and all mistakes that might occur in a patent caused by the USPTO. Indeed, inspection of typical errors in claim scope corrected by Certificates of Correction issued by the USPTO under § 254 reveals that claims have been deleted, which is, of course, the ultimate narrowing of the scope of a claim, as well as added, which is the ultimate in according scope to the added claim, and various intermediate changes in the scope of claims as printed, have likewise been effectuated. For example, a Certificate of Correction under § 254 was issued on July 31, 2001, to U.S. 6,019,809, that deleted claims 1 through 5, which notwithstanding their prior cancellation by applicant, were inadvertently printed in the patent. The corrective cancellation of these claims meant, of course, that the patent had never issued with that subject matter claimed, and as such, the scope of the patent's claims had been narrowed. On the same date, a Certificate of Correction under § 254 was issued to U.S. 6,018,312, to add an entire last step "(e)" involving calculation, to method claim 1, that had inadvertently not been printed in the

⁸ A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available for the correction of applicant's errors of only a minor or clerical character, and does not extend to the correction of applicant's errors that would constitute new matter or would require reexamination. See *In re Arnott*, 19 USPQ2d 1049, 1054 (Comm'r Pat. 1991); *In re Hyman*, 185 USPQ 441, 442 (Sol. Pat. 1975). Specifically, 35 U.S.C. § 255 requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that applicant's mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would require reexamination. See *Arnott* 19 USPQ2d at 1052; see also MPEP 1485.

patent. The corrective addition of this further limitation, meant, of course, that the patent as issued now required 5 processing steps (a through e), and not 4 (a through d) as printed, and as such, the scope of claims 1 *et seq.* had been narrowed. On May 28, 2002, a Certificate of Correction under § 254 was issued to U.S. 6,027,798, to add two dependent claims that had inadvertently not been printed in the patent. By definition, these dependent claims presented an additional limitation(s) that further modified or restricted the scope of claim 13 upon which they depended, see 35 U.S.C. § 112, paragraph 4, and as such, the scope of claim 13 was narrowed.

As to the third item noted above, petitioner contends that as the "alleged error" is not a "mistake of consequence" within the meaning of MPEP § 1480, a Certificate of Correction should not issue. Petitioner further points to litigation in progress involving the as-printed patent, and that any forthcoming Certificate of Correction under § 254 would have no consequence on the already-pending litigation, and cites Harlequin, *supra*, in support of his contention.

Petitioner appears to misconstrue § 1480 of the MPEP, which merely recounts the discretionary authority of the USPTO with respect to correcting its own mistakes under § 254, when its limited resources are balanced against the need for the public to have correct information about patents that the USPTO has printed. As noted above, the mistake in the above-identified patent as printed is clearly disclosed within the meaning of § 254 by the records of the USPTO. Indeed, petitioner acknowledges that the claims as unfortunately printed have already been asserted against a member of the public. It is well settled that the claims of the patent as printed constitute public notice of the scope of the patent grant. *See e.g., Warner Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997). However, the public is also entitled to rely upon the public record, including the prosecution history, of a patent in determining the scope of the patent's claims. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996); *Vectra Fitness v. TNWK Corp.*, 162 F.3d 1379, 1384, 49 USPQ2d 1144, 1148 (Fed. Cir. 1998). This reliance enables businesses, as well as others, to plan their future conduct in as certain an environment as possible. *Vitronics, Id.*⁹ Where, as here, there is a clearly disclosed discrepancy between the public record of the patent file prosecution history and the patent as printed, this discrepancy creates an ambiguity as to where the public may properly place its reliance: the public record or the printed copy of the patent. Here, staying the Certificate of Correction would tend to maintain the uncertainty of this environment for businesses and others in planning their future conduct, and tend to decrease the ability of the public to rely on the public record of this patent. That litigation may already be underway involving one member of the public is immaterial to the USPTO exercising its discretionary authority to correct its own mistake for the benefit of both the patentee and the public. Issuance of the Certificate of Correction will tend to render the business environment more certain, and further, both the public notice effect of the public record of this file and the public notice effect of the issued claims as amended by the Certificate of Correction will be in harmony. Since the records of the USPTO clearly disclose the existence of a mistake in the scope of the claims as now printed in the patent when compared to the scope of the claims that were actually passed to issue by the

⁹ For example, the "recapture rule" prevents a patentee from regaining through reissue subject matter surrendered during prosecution, thus ensuring the ability of the public to rely on a patent's public record. *See In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

examiner, it is in the interest of both the patentee and the public for the USPTO to issue a Certificate of Correction under § 254 and 37 CFR 1.322.

DECISION

The petition is granted to the extent that the Office communication of May 5, 2003, has been reconsidered, but for the reasons given above is **dismissed** as to the request for an order staying issue of a Certificate of Correction under § 254 and 37 CFR 1.322. The USPTO will exercise its discretion in this instance and correct its own mistake that is clearly disclosed by the records of the Office.

This patent file is being forwarded to Certificate of Correction Branch for processing of the Certificate of Correction.

Telephone inquiries related to this decision may be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

A handwritten signature in black ink, appearing to read 'Charles Pearson', with a long horizontal flourish extending to the right.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy